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DATE: October 17, 2001

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TO: Commissioner of Patents
Examiner Raymond Covington
Group Art Unit 1625

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FROM: Wendy Lei Hsu, Patent Counsel/Reg. No. 42,794

RE: Application No. 08/916,527 – Filing Date: 08/22/97
For: Neuropeptide-Y Ligands

DOCKET : 0035-01 US/ALANEX.006A

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CERTIFICATE OF FAX FILING:

The undersigned hereby certifies that the enclosed papers, Request For Reconsideration Under 37 C.F.R. §1.111 and Associate Power of Attorney, are being submitted via the above-identified facsimile number on the above-noted date.

Wendy Lei Hsu

NO CONFIRMATION WILL BE SENT.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re U.S. Patent Application of:	Hong et al.	Examiner: R. Covington
Serial No.:	08/916,527	Group Art Unit: 1625
Filed:	August 22, 1997	
For:	NEUROPEPTIDE-Y LIGANDS	Atty. Docket No.: ALANEX.006A

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

Commissioner For Patents
Washington, DC 20231

Sir:

This is a response to the Office Action dated July 31, 2001.

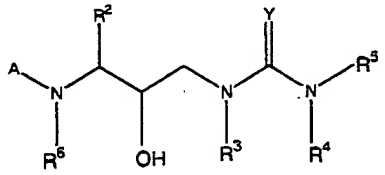
Claims 11-25 are pending. These claims remain rejected under 35 U.S.C. 103(a) based on U.S. Patent No. 5,482,947 (Talley et al.) in view of U.S. Patent No. 5,380,945 (Murad et al.). Applicant respectfully requests reconsideration and withdrawal of the rejection based on the following remarks.

In rejecting the claims, the Examiner stated:

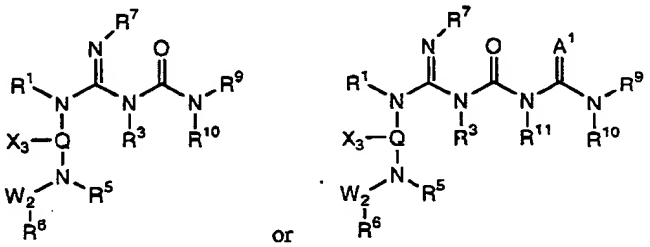
> The references are applied as in the last Office Action. Applicants' comments have been noted and considered with the following effect. The scope of the applicants' claims read on patentable as well as unpatentable subject matter. This is particularly true when, for example [R^1, R^3], R^5, R^6, R^7, R^9, R^{10}, X^3 are hydrogen, W_2 is a bond and Q is carbon. These particular derivatives are well-known in the art. However, the elected species and generically related species are otherwise allowable. Limitation of the scope of the invention should render the claims allowable.

As discussed in previous responses dated April 30, 2001 and October 10, 2000, however, the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner has again failed to identify the specific differences between the compounds of Talley et al. and the compounds of the claims, and has further failed to explain why an artisan would have been motivated to modify the compounds of Talley et al. so as to achieve the compounds of the present invention.

Talley et al. discloses retroviral protease inhibitors having the formula:



By contrast, the claimed compounds have the formula:



Even when R^1, R^3, R^5, R^6, R^7, R^8, R^9, R^{10}, and X^3 are hydrogen, W_2 is not present, and Q is $-CH_2-$, the backbone of the claimed compounds is different from that of the Talley et al. compounds. Thus, contrary to the Examiner's assertion, the Talley et al. reference fails to show that the claimed compounds are well known.

The Murad et al. reference fails to remedy the deficiencies of Talley et al. The test for obviousness is whether the differences between the claimed invention and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Ecolochem v. Southern California Edison, 227 F.3d 1361, 1371; 56 U.S.P.Q.2d 1065 (Fed. Cir. 2000), citing 35 U.S.C. § 103(a). In Ecolochem, the Federal Circuit overturned a finding of obviousness, stating "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" 227 F.3d at 1372. Here, too, the rejection is supported by nothing more than broad conclusory statements. Moreover, it is devoid of any identification of the differences between the prior art and claimed invention. Consequently, the rejection is in error and should be withdrawn.

For the foregoing reasons, compound claims 13-25, composition claim 12, and method claim 11 patentably define over the prior art. Accordingly, claims 11-25 are allowable. Applicant therefore requests favorable action.

If any fees are due in connection with the filing of this response, including any fee for any necessary extension of time, for which Applicant hereby petitions, please charge all such fees to Deposit Account No. 500329.

Respectfully submitted,

Wendy Lei Hsu

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Date: October 17, 2001

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